

REMARKS

Applicant appreciates the examiner's thorough review of the application and the indicated allowability of Claims 2 and 6. Applicant also appreciates Examiner's faxed copy of the translation of the Suzuki reference. Reconsideration and allowance are respectfully requested.

The objection to the specification has been overcome by canceling the paragraph cited by the Examiner as suggested.

No new matter has been added by the amendments. Claims 2 and 6 have been amended to put them in independent form and place them in condition for allowance. Claim 3 has been amended to clarify that the fixed valve stem part is the outer valve stem part as described in Claim 1. By that amendment, the Examiner's rejection of Claim 3 under 35 U.S.C. 112, second paragraph is overcome.

Claims 1 and 3-5 are patentable under 35 U.S.C. 102(b) over Suzuki et al. (JP61197757).

For an invention to be anticipated, it must be demonstrated that each and every element of the claimed invention is present in the "four corners" of a single prior art, either expressly described therein or under the principle of inherency. Lewmar Marine Inc. v Barient Inc., 3 USPQ2d 1766, 1767-1768 (Fed. Cir. 1987) (emphasis added). The absence from a prior art reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible, Inc., 230 USPQ 81, 84 (Fed. Cir. 1986).

Suzuki teaches a diesel engine with a fuel injection valve 21 wherein the fuel injection direction can be changed without decomposing the valve. The valve 21, of which holder 22 is one part, contacts a cylinder cover 3 at contact surface 23. The entire fuel injection valve 21 can be rotated about point A (Abstract).

In the view of Figure 1, rotating the valve clockwise leads to a valve position as shown by

one set of dashed lines and a spray angle shown by the upper dashed line corresponding to mist 10, representing an increased angle θ as shown in Figure 6b (Page 2, lines 21-23, "the angle from the plane perpendicular to cylinder axis 16 is taken as θ_i ...", see Figure 1, dashed lines showing possible angles for mist 10, dashed lines showing possible positions for holder 22 and flange 26, Page 3, line 29 - Page 4, line 2, "conical spaces 28, 29 are formed for the movement of holder 22 and atomizer 7..."). This rotation is possible because of the spherical contacts 27 of the flanges, etc. Flange 26 appears to press on needle 38, deflecting it to various extents depending on the rotation of the valve 21 about point A, giving a reading of the angle of the valve on needle 37 in angle indicator 39 (Page 4, lines 5-6).

Claim 1 teaches an oil injecting valve for lubricating/flushing engine cylinders. Claim 1 is distinguished from Suzuki at least in that it teaches at least one nozzle outlet is disposed in the inner valve stem part which is rotatable relative to an outer valve stem part. Suzuki does not teach or suggest this feature. The Examiner cites element 9 of Suzuki (not described in the Abstract) as the nozzle outlet and fuel injection valve 21 as the inner valve stem part and holder 22 as the outer valve stem part.

However, a careful look at Figure 1 makes it apparent that holder 22 is a part of valve 21. The element number 21 points with an arrow to the outside surface of holder 22, indicating that the fuel injection valve 21 encompasses the holder 22 and more. Therefore it cannot be said that they are separate parts, or that element 21 could possibly rotate inside element 22. In fact, the entire valve of Suzuki, including the holder 22, rotates together freely about point A (Page 4, line 10, "when the injecting direction is to be changed, one may simply move holder (22)", lines 16-17, "by moving the overall fuel injection valve, it is possible to change the fuel injection

direction."). Suzuki does not teach at least one nozzle outlet is disposed in the inner valve stem part which is rotatable relative to an outer valve stem part, and therefore fails to anticipate Claim 1.

Claim 1 is further distinguished from Suzuki at least in that it teaches a valve stem extending through the cylinder wall and that the outer valve stem part is fastened to or made as an integral part of the mounting means. Suzuki does not teach or suggest any of these features. Examiner cites fuel injection valve 21 of Suzuki as a valve stem and cylinder cover 3 as the cylinder wall. However, the Abstract says nothing about a valve stem extending through a cylinder wall. The reference cannot be said to teach a valve stem extending through the cylinder wall.

Examiner cites fixing tool 33 as a mounting means and holder 22 as an outer valve stem part. Holder 22 is not an outer valve stem part, as explained above. Furthermore, it is not fastened to or made as an integral part of the mounting means. Holder 22 is part of the valve 21 that is freely rotatable about point A and therefore rotates freely with respect to the fixing tool 33. In no way is it fastened to the fixing tool.

Dependent Claims 3-5

Claims 3-5 depend from independent and patentable Claim 1 and add further patentable features. For example, Claim 3 adds that that the rotatable valve stem part includes two annular clamping faces disposed at each side of an annular flange on the outer valve stem part, and which is provided with means for clamping the clamping faces against the flange for securing mutual position of the two valve stem parts.

Examiner asserts that Suzuki teaches this feature, but is incorrect. Examiner is unable to cite to annular clamping faces in Suzuki because none are described therein. Applicant requests that the Examiner either withdraw this rejection or point out specifically where Suzuki teaches this element. Similarly, the Examiner has failed to allege or identify a means for clamping or that a mutual position of two valve stem parts is secured.

Claim 5 adds that the at least one nozzle outlet is provided for forming one or more injection jets or oil mists oriented symmetrically relatively to the valve stem. Suzuki does not teach or suggest this feature. Examiner cites Figure 6 as showing a "symmetrical spray pattern." The sprays shown in Figure 6 do not appear to be symmetrical in any way relative to a valve stem.

Suzuki does not teach each and every element of the claimed invention. For at least the reasons given above, the rejection of Claims 1 and 3-5 under 35 U.S.C. 102(b) over Suzuki is improper and should be withdrawn.

Claim 7 is patentable under 35 U.S.C. 103(a) over Suzuki et al. (JP61197757) in view of Yamamoto et al. (US 5,740,777).

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

Claim 7 depends from independent and patentable Claim 1 and adds an oil filter. Examiner allows that Suzuki does not teach or suggest this feature. Examiner therefore cites Yamamoto generally as teaching this feature. Yamamoto is 41 pages long and Applicant requests that the Examiner point out where Yamamoto teaches a valve for injecting oil comprising an oil filter. Yamamoto refers to a filter for fuel, not an oil filter. Therefore Yamamoto and Suzuki, even if they could be combined in the way suggested by the Examiner, would not teach or suggest all the claim limitations of Claim 7. For at least this reason, the rejection of Claim 7 under 35 U.S.C. 103(a) over Suzuki in view of Yamamoto is improper and should be withdrawn.

CONCLUSION

Reconsideration and allowance are respectfully requested.

Respectfully,



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